



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/816,352	03/26/2001	Akihiro Tozaki	Q63622	6361

7590 07/20/2006

SUGHRUE, MION, ZINN, MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue
Washington, DC 20037-3202

EXAMINER

RIMELL, SAMUEL G

ART UNIT	PAPER NUMBER
----------	--------------

2164

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/816,352

Applicant(s)

TOZAKI ET AL.

Examiner

Sam Rimell

Art Unit

2164

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 17-18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


SAM RIMELL
PRIMARY EXAMINER

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Art Unit: 2164

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 20: Claim 20 refers the occurrence of a mismatch. While the original disclosure in FIG. 8 does recognize the step of determining a mismatch of dates, it does not recognize determinations for generic mismatching, or mismatching which is not necessarily related to dates. Accordingly, the recitation of a “mismatch” is broader than what is permitted in the original specification and therefore is considered to define new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 20-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 20: It is not clear whether the recited “mismatch” is based on the previously recited step of comparing in claim 20, or is instead based on some other manner of mismatching.

Claim 21: Depends on claim 20.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4-7 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tognazzini (U.S. Patent 6,600,713).

Claim 1: Tognazzini discloses a compact disk having read only areas (101) and read/write areas (102, 103). The read/write areas (102, 103) may include updates to the permanently stored information on the read only area (col. 5, lines 11-14).

A serial number may further be recorded on the disk in the read/write area (col. 5, lines 48-60) and readable as “file management information”. The serial number uniquely identifies the disk (col. 5, line 56), and thus serves as “volume configuration information”. The serial number also identifies user input information (col. 6, lines 20-27), and thus also reads as “file configuration information”.

The read/write area may also include file configuration information composed of : name and size information (a playback program for a series of songs—col. 5, lines 66-67, which would indicate which songs (name information) and the total number of songs in the series to be played back (size information)); a position on the volume (the position of the user, col. 6, line 6); and access control information (preferred settings of equipment, col. 6, line 1). This file configuration information is recorded in the read/write area (col. 6, lines 17-19).

No patentable weight is attributable to the phrase “for managing the pre-recorded file and the updated version of the pre-recorded file, since it pertains to an intended usage of the file

Art Unit: 2164

management information, rather than the actual structure or content of the file management information. Accordingly, it carries no patentable weight.

Claim 4: Col. 4, line 60 through col. 5, line 3 describe the system as an optical disk having at least two recordable surfaces. The read/write surface exists on two of the surfaces.

Claim 5: The optical disk includes read only surfaces and read/write surfaces, both of which are irradiated by a laser beam (col. 4, line 60 through col. 5, line 3).

Claim 6: FIG. 3 discloses a controller which is readable as a server, and a CPU which is readable as a “server information acquisition section”. The read heads are the “hybrid information acquisition section”. The file management information is the serial number recorded on the read/write portion of the disk. The computer program described at col. 6, lines 21-28 read as a file information comparator and file acquisition section since this program compares the serial number read by the read heads and acquires records and control information based on the serial number. The file write heads read as the “file write section” and file re-writing section” since they are capable of writing and re-writing files based on specific user actions or inputs.

Claim 7: See remarks for claim 1.

Claim 19: The subject matter of claim 19 is directed entirely to the content of management information. Since the information itself is not interacting with a machine or causing a change in the functionality of a machine, it is non-functional descriptive material and thus does not distinguish from the prior art in terms of patentability. See *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004) and *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983).

Art Unit: 2164

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tognazzini (U.S. Patent 6,600,713) in view of Official Notice.

Claim 3: Tognazzini teaches that the read only area may contain multiple files, such as music files, but not a single file.

However, the Examiner takes Official Notice that the skilled artisan would readily recognize that a compact disk may contain any number of files, from zero files, one file, two files, or hundreds of files, depending upon the physical limitations of the disk. Accordingly, it would have been obvious to one of ordinary skill in the art to modify Tognazzini to include only a single file (such as a single song) in the read area as a user desired option which is readily recognizable by the person of ordinary skill in the art. A single file can be a "file portion" (an entire portion of the file).

Claims 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

Remarks

Based on applicant's amendment, allowable subject matter is now indicated for claims 17, 18 and 21.

With respect to claim 1, applicant argues that claim 1 has been amended to define both volume configuration information and file configuration information, where the file configuration information includes a name. Examiner maintains that both of these features are present in Tognazzini. See the discussion associated with claim 1, second and third paragraphs. Tognazzini discloses a serial number as file management information and identified songs which are name information.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2164

Any inquiry concerning this communication should be directed to Sam Rimell at telephone number (571) 272-4084.

A handwritten signature in black ink, appearing to read 'S. Rimell', is positioned above the printed name.

Sam Rimell
Primary Examiner
Art Unit 2164